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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91161817
Party	Plaintiff Nextel Communications, Inc.
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Date	06/07/2006
Attachments	Amended Notice of Opposition.pdf (7 pages)(223607 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE
THE TRADEMARK TRIAL AND APPEAL BOARD

NEXTEL COMMUNICATIONS, INC.,)

Opposer,)

v.)

MOTOROLA, INC.,)

Applicant.)

Opp. No.: 91/161,817

App. No.: 78/235,618

Pot. Mark: SENSORY MARK
(911 Hz tone)

BOX - TTAB – NO FEE

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514

AMENDED NOTICE OF OPPOSITION

Honorable Commissioner:

NEXTEL COMMUNICATIONS, INC. (“Opposer”), a corporation duly organized and existing under the laws of the State of Delaware, located and doing business at 2001 Edmund Halley Drive, Reston, VA 20191, believing that it will be damaged by registration, hereby opposes Application Serial No. 78/235,618, filed April 9, 2003, under the Trademark Act of 1946, as amended (“Lanham Act”), in the name of MOTOROLA, INC. (“Applicant”).

The amended grounds for opposition are as follows:

1. Opposer is one of the largest providers of cellular telephone and dispatch communications services in the United States, and currently has over 17 million subscribers to its services nationwide.

2. Opposer and Applicant have a long-standing business relationship, whereby Applicant manufactures phones, and accessories therefor, for sale by Opposer for use with Opposer's cellular telephone and dispatch services.

3. Applicant manufactures phones and accessories for Opposer's direct competitors.

4. On April 9, 2003, Applicant filed an application for registration of an electronic sound consisting of a tone at 911 Hz played at a cadence of 25 milliseconds (ms) on, 25 ms off, 25 ms on, 25 ms off, 50 ms on ("911 Hz Tone Application"). The 911 Hz Tone Application was assigned Serial No. 78/235,618, and was published for opposition in the Official Gazette on February 24, 2004. As published for opposition, the goods recited in the 911 Hz Tone Application are "[t]wo-way radios."

5. The 911 Hz Tone Application was filed under Section 1(a) of the Lanham Act, and claimed May 6, 1991, as the date of first use and the date of first use in commerce.

6. On October 17, 2003, the United States Patent and Trademark Office ("USPTO") issued an Office Action in connection with the 911 Hz Tone Application, requiring a description of the 911 Hz tone and a specimen evidencing use of the 911 Hz tone in commerce.

7. On October 17, 2003, Applicant submitted a response to the USPTO Office Action. The response included a description of the 911 Hz tone as follows:

“[t]he mark is an electronic chirp consisting of a tone at 911 Hz played at a cadence of 25 ms ON, 25 ms OFF, 25 ms ON, 25 ms OFF, 50 ms ON.”

8. Applicant’s response to the USPTO Office Action also included a specimen of use in the form of a compact disc described as “[a] sound file that contains a sound that emanates from a two-way radio to alert user or receiver of an incoming call or the availability to speak.” The specimen was asserted to have been in use in commerce since at least as early as the filing date of the application.

9. Upon information and belief, Applicant has not used the 911 Hz tone as a mark in commerce in connection with the goods listed in the 911 Hz Tone Application, in derogation of Sections 1 and 45 of the Lanham Act. *See* 15 U.S.C. §§ 1051, 1127.

10. Upon information and belief, the 911 Hz tone is not inherently distinctive and has not acquired distinctiveness as to the goods listed in the 911 Hz Tone Application, in derogation of Sections 1, 2, and 45 of the Lanham Act. *See* 15 U.S.C. §§ 1051, 1052, 1127.

11. Opposer is the owner of a mark consisting of a tone at 1800 Hz played at a cadence of 24 milliseconds (ms) ON, 24 ms OFF, 24 ms ON, 24 ms OFF, 48 ms ON (“Nextel Chirp”), and of Federal Trademark Application Serial No. 78/575,442, for registration of the Nextel Chirp in connection with “Telecommunication services, namely, electronic, electric and digital transmission of voice, data, pictures, music, video, and other information via wireless networks; Two-way radio services; Electronic transmission of voice, text, images, data, music and information by

means of two-way radios, mobile radios, cellular telephones, digital cellular telephones, mobile telephones, handheld units, namely, personal computers and digital assistants (PDAs), dispatch radios, and pagers; Paging services; Transmission of positioning, tracking, monitoring and security data via wireless communications devices; Mobile telephone communication services; Wireless Internet access services; Wireless data services for mobile devices via a wireless network for the purpose of sending and receiving electronic mail, facsimiles, data, images, music, information, text, numeric messaging and text messaging and for accessing a global communications network; Telecommunication services, namely, providing user access to telephone and Internet wired or wireless networks for the transmission of voice, data, images, music or video via a combination of persistent interconnection and instant interconnection/instant interrupt technologies; Wireless communications services,” in International Class 38 (“Nextel Chirp Application”).

12. Opposer has a direct commercial interest in preventing improper federal registration of the 911 Hz tone as a trademark. For many years, Opposer has used the Nextel Chirp extensively in the marketing and promotion of its services. Opposer has spent many millions of dollars on advertising and other forms of marketing that feature the Nextel Chirp as a mark. Upon information and belief, Applicant has indicated that it may assert any federal registration it may obtain for the 911 Hz tone against Opposer, by seeking to prevent Opposer from obtaining products that emit the Nextel Chirp from suppliers other than Applicant, or from marketing Opposer’s own services under the Nextel Chirp, or from enjoying

exclusive use of the Nextel Chirp vis-à-vis Opposer's competitors who acquire products from Applicant, or from obtaining federal trademark registration of the Nextel Chirp. Each or any of these events will cause injury to Opposer and impinge on its rights. Accordingly, Opposer will be damaged by the unjustified registration by Applicant of the 911 Hz tone as set forth in the 911 Hz Tone Application.

WHEREFORE, Opposer, NEXTEL COMMUNICATIONS, INC., believes and avers that it will be damaged by registration of the 911 Hz tone as aforesaid, and prays that said Application Serial No. 78/235,618 be rejected, that no registration be issued thereon to Applicant, and that this Opposition be sustained in favor of Opposer.

Opposer has appointed JOHN I. STEWART, JR., JEFFREY D. SANOK, and MICHAEL H. JACOBS, members of the law firm of **CROWELL & MORING LLP**, and members of the Bar of the District of Columbia, to prosecute this Opposition proceeding and to transact all business in and before the United States Patent and Trademark Office in connection herewith. Please address all correspondence to:

John I. Stewart, Jr.
Crowell & Moring LLP
1001 Pennsylvania Avenue, NW
Washington, DC 20004
Telephone No.: (202) 624-2500
Facsimile No.: (202) 628-5116

The filing fee in the amount of \$300.00 was submitted with the originally filed Notice of Opposition. Please credit any overpayments or charge any additional fees to the Deposit Account of Crowell & Moring LLP, Account Number 05-1323 (Docket #100773.92133US).

Respectfully submitted,

A handwritten signature in cursive script, reading "John I. Stewart, Jr.", written over a horizontal line.

John I. Stewart, Jr.
Attorney for Opposer

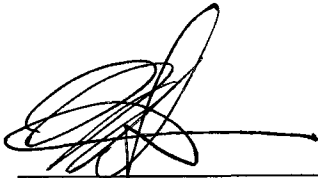
June 7, 2005

CROWELL & MORING LLP
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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the AMENDED NOTICE OF
OPPOSITION was served on counsel for the Applicant, this 7th day of June, 2006,
by sending same via e-mail and First Class Mail, postage prepaid, to:

John T. Gabrielides
Thomas Williams
BRINKS HOFER GILSON & LIONE
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William J. Sauers